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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,229	07/18/2003	Joseph F. Bringley	86583PAL	4664

7590

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EXAMINER

SCHWARTZ, PAMELA R

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/622,229

Applicant(s)

BRINGLEY ET AL.

Examiner

Pamela R. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/19/03</u> | 6) <input type="checkbox"/> Other: ____ |

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1. The disclosure is objected to because of the following informalities: the disclosure describes the term "metal oxyhydroxy complex" with a formula that does not require the presence of oxygen ions.

Appropriate correction is required.

2. Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "metal oxyhydroxy complexes" as used in claim 24 and described by applicants' specification is inconsistent with its well-known meaning in the art. In the art, this term would require the presence of metal, oxygen, and hydroxyl ions in the complex. However, the formula provided for the complexes in the specification would permit there to be no oxygen ions present. Since there is no limiting definition of the term in the specification, applicants should either recite that "a" is greater than zero, or should modify the term used to describe the complexes so that it is consistent with chemical nomenclature.

3. Since both a support and a binder are required to form an image receiving element in accordance with applicants' invention (see page 9), the claims will be treated as if they recite these necessary portions of the element.

4. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darsillo et al. (6,365,264). The reference discloses a recording medium having a glossy coating thereon with first and second groups of particles (see the abstract). The first particles may be pyrogenic silica and may be treated to make it cationic with aluminum chlorohydrate (see col. 4, line 59 to col. 5, line 10). This treatment should create an

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alumino silicate shell on the particles. The ratio of the groups of particles to each other overlaps with those instantly claimed (see the abstract). The second group of particles may be colloidal silica and may be surface treated (see col. 8, line 51 to col. 9, line 9). The make the particles cationic, treatment with alumina, forming an aluminosilicate shell, would have been obvious to one of ordinary skill in the art since it is well know that alumina is cationic and will cause the surface of the silica to become cationic if so treated. The first group of particles has a primary particle size of less than about 100 nm with aggregates of from about 100 to about 500 nm. The second set of particles are less than about 50% of the mean diameter of these aggregates (see the abstract). The reference is concerned with gloss but does not measure gloss in the terms of claims 11 and 12. However, based upon the discussion of glass in col. 3 of the reference, it would have been obvious to one of ordinary skill in the art to control and determine gloss of the medium in order to achieve desired visual results. Due to the small particle range set forth at col. 5, lines 11-42, the first group of particles would inherently meet the standard deviation values of claims 13 and 14. Furthermore, the reference suggests that both sets of particles can have diameters that are all substantially the same (see col. 6, lines 51-63 and col. 8, lines 14-28). The larger particles may be pyrogenic or fumed silica. The smaller particles may be colloidal silica. The colloidal silica set forth in Example one is spherical. Pyrogenic silica is usually formed into chains that would be of irregular shape. Therefore, these aspects would have been obvious to one of ordinary skill in the art. The medium of the reference would be inherently porous (see col. 7, lines 6-9) although the reference does not appear to set forth the porosity of the

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layer. Based upon the awareness of the importance of this property by the applied art, it would have been obvious to one of ordinary skill in the art to optimize the porosity of the layer in order to obtain desired ink absorption capacity.

5. Claims 1 and 3-22 are directed to an invention not patentably distinct from claims 1-20 of commonly assigned 6,447,111. Specifically, the claims disclose encapsulated inorganic particles (colloidal silica), inorganic particles (fumed silica) from about 7 to about 40 nm, wherein the first inorganic particles are surface modified with a silane-containing material (see Table 1). Percentages of materials are set forth in claim 18. See claim 14 for the recitation of surface modification of inorganic particles with a silane containing material and col. 5 for the specific silane-containing materials. It would have been obvious to one of ordinary skill in the art to determine well known properties, such as gloss and porosity, in order to obtain desired properties in the recording material. It would have been obvious to one of ordinary skill in the art to determine the shape of inorganic particles and colloidal particles from those conventionally used in the recording art. Obtaining small deviations in particle size using commercially available materials is considered to be obvious when following the ranges set forth by the reference.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 3-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S.

Patent No. 6,447,111. Although the conflicting claims are not identical, they are not patentably distinct from each other because of reasons set forth in paragraph 5 above.

7. Claims 1 and 3-22 are rejected under 35 U.S.C. 103(a) as being obvious over Gallo et al. (6,447,111). The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned

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by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

In addition to reasons for obviousness set forth in paragraph 5 above, see col. 3, lines 15-46 with respect to scattering of light (i.e. recognition of importance of gloss), col. 5, line 18 to col. 7, line 40 for the encapsulated inorganic particles and the ratios of particles, and Example 1.

8. Claims 1 and 3-22 are directed to an invention not patentably distinct from claims 1-20 of commonly assigned 6,645, 582. Specifically, the claims disclose encapsulated inorganic particles (colloidal silica), inorganic particles (fumed silica) from about 7 to about 40 nm, wherein the first inorganic particles are surface modified with a silane-containing material (see Table 1). Percentages of materials are set forth in claim 18. See claim 14 for the recitation of surface modification of inorganic particles with a silane containing material and col. 5 for the specific silane-containing materials. It would have been obvious to one of ordinary skill in the art to determine well known properties, such as gloss and porosity, in order to obtain desired properties in the recording material. It would have been obvious to one of ordinary skill in the art to determine the shape of inorganic particles and colloidal particles from those conventionally used in the recording art. Obtaining small deviations in particle size using commercially available materials is considered to be obvious when following the ranges set forth by the reference.

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

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F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 3-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S.

Patent No. 6,447,111. Although the conflicting claims are not identical, they are not patentably distinct from each other because of reasons set forth in paragraph 8 above.

10. Claims 1 and 3-22 are rejected under 35 U.S.C. 103(a) as being obvious over Sadasivan et al. (6,645,582). The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer

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in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

In addition to reasons for obviousness set forth in paragraph 5 above, see col. 3, lines 12-33 with respect to scattering of light (i.e. recognition of importance of gloss), col. 5, line 4 to col. 7, line 30 for the encapsulated inorganic particles and the ratios of particles, and Example 1.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Schwartz whose telephone number is (571) 272-1528.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRSchwartz
January 10, 2005



Robert J. Schwartz
Patent Attorney